

Notice of Allowability**Application No.**

10/565,116

Examiner

RONALD HUPCZEY, JR

Applicant(s)

WOLOSZKO ET AL.

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the response filed March 30th, 2011.
2. ☒ The allowed claim(s) is/are 1,6-18,20-40,57 and 61.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: ____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date ____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 1/11/2011, 3/30/2011
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 20110701.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other ____.

/Ronald J. Hupczey/
Examiner, Art Unit 3739

DETAILED ACTION

1. Applicant's amendments and remarks, filed March 30th, 2011, are fully acknowledged by the Examiner. Currently, claims 1-3, 6-18, 20-57 and 59-61 are pending with claims 4-5, 19 and 58 cancelled, claims 1, 10, 17-18, 20, 29, 33, 35, 57 and 59 amended, claims 2-3 and 41-56 withdrawn and claim 61 newly added. The following is a complete response to the March 30th, 2011 communication.

Information Disclosure Statement

2. The IDS's filed January 11th, 2011 and March 30th, 2011 have been considered by the Examiner.

EXAMINER'S AMENDMENT

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Matthew Scheele on July 1st, 2011.

The application has been amended as follows:

- Please cancel claims 59 and 60.

Allowable Subject Matter

4. This application is in condition for allowance except for the presence of claims 2-3 and 41-56 directed to Species II and III which were non-elected without traverse as noted in the June 8th, 2009 non-final office action. Accordingly, claims 2-3 and 41-56 have been cancelled. It is

noted that each of independent claims 1, 10, 17, 29 and 35 contain language which is specific only to elected species I and is not consider to the be generic to the remainder of the non-elected species.

5. Claims 1, 6-18, 20-40, 57 and 61 are allowed.
6. The following is an examiner's statement of reasons for allowance:

During the search of the prior art of record, a plurality of references were found which disclose various portions of the instant inventions claimed. West (US 2003/0163126) was previously relied upon to teach a majority of the structural features as well as the methodology claimed. However, each of claims 1, 10, 17, 29 and 35 have been amended to required that an active electrode is disposed on a first portion of the *tissue removal port edge* and that a return electrode is dispose on a second portion of the *tissue removal port edge*. With respect to figures 5 and 6 of West, while the tubular member **54** can be seen as forming the tissue removal port and, therefore, forming an electrode on the tissue removal port edge, the remainder of the electrodes, leads **64**, are clearly formed away from the tissue removal port edge and cannot be taken as on the edge of the tissue removal port. Other art considered particularly relevant by the Examiner includes: Wrublewski (US 6,193,715 B1), Peters (US 6,663,628 B2), Adams (US 6,979,332 B2), and McDonald (US 7,150,747 B1). While this prior art exhibits some of the features of the instant independent claims no piece of prior art whether alone or in combination with the West reference discloses, suggests or makes obvious the placement of an active electrode disposed on a first portion of the tissue removal port edge and a return electrode disposed on a second portion of the tissue removal port edge.

It is noted by the Examiner that Applicant has clearly provided support for the limitation of the "tissue removal port edge" in the instant disclosure. With respect to the elected species I shown in figures 5A-5F, the electrodes at 514 and 518, in figures 5A-5E, are disposed with respect to the tissue removal port 550. Specifically, the electrodes are stated as being on the perimeter in lines 24-25 of page 22 of the originally file specification. Additionally, such a placement is further described with respect to the electrode placement in figure 5F as being disposed "along the perimeter or edge of the port" (see page 23, lines 31-32). As such, the Examiner believes that Applicant has clearly defined the placement of the electrodes on the edge of the tissue removal port thereby requiring a placement of the electrodes in instant claims as depicted in figures 5A-5E. It is for at least the reasoning above that the Examiner believes that the instant claims are distinguished from the prior art of record and are, therefore, allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RONALD HUPCZEY, JR whose telephone number is (571)270-5534. The examiner can normally be reached on Monday - Friday, 9 A.M. to 5 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ronald J. Hupczey/
Examiner, Art Unit 3739

/Michael Peffley/
Primary Examiner, Art Unit 3739

RJH